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EXAMINER

HARLE, JENNIFER I

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,495

Applicant(s)

HORENSTEIN ET AL.

Examiner

Jennifer I. Harle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 21-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5, 21-71 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-15 were pending. Claim 16 was withdrawn from consideration. Claims 1-3 have currently been amended; claims 6-20 are canceled, and claims 21-71 have been added by Applicants' Amendment, filed July 14, 2004. Thus, claims 1-5 and 21-71 are currently pending.

Response to Amendment

As the Markush group set forth in the claims includes both independent and distinct inventions, and patentable distinct compounds (or species) within each invention, which are far too numerous to list individually and create an incredible burden to search and examine, the examiner is withdrawing the previous Election/Restriction and sets forth the new Election/Restriction below.

The examiner notes that Applicants contend that the elected species is directed to patentable subject matter. However, at this point the examiner is unable to make such a determination and as all the claims still encompass the previously elected species, Applicants' will be afforded the ability to elect this species again, if they so desire.

The 102(b) rejections previously set forth have been withdrawn in light of Applicants' amendments.

Election/Restrictions

The Markush group set forth in the claims includes both independent and distinct inventions, and patentable distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentable distinct inventions far too numerous to list individually. Moreover, each of these inventions contains a plurality of patentable distinct compounds, also far too numerous to list individually. For these reasons provided below,

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restriction to one of the following groups is required under 35 U.S.C. 121, where a group is a set of patentable distinct invention of a broad statutory category (e.g. compounds, methods of use, methods of making, etc.):

1. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z are each carbon, classified in various classes except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
2. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z are each carbon, classified in various classes where any of the R groups contain a sugar/sugar residue.
3. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z are each carbon, classified in various classes where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
4. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z are each carbon, classified in various classes where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
5. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z are each carbon, classified in various classes where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.

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6. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z are each carbon, classified in various classes where any of the R groups contain a nucleoside triphosphate but not a nucleoside monophosphate or nucleoside diphosphate.
7. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z together make a pyrrolidine or pyrroline ring which is fused with a cyclopropyl ring in class 548, subclass 452+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
8. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z together make a pyrrolidine or pyrroline ring which is fused with a cyclopropyl ring in not classified in class 548, subclass 452+ where any of the R groups contain a sugar/sugar residue.
9. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z together make a pyrrolidine or pyrroline ring which is fused with a cyclopropyl ring in not classified in class 548, subclass 452+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
10. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z together make a pyrrolidine or pyrroline ring which is fused with a cyclopropyl ring in not classified in class 548, subclass 452+ where any of the R

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groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.

11. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z together make a pyrrolidine or pyrroline ring which is fused with a cyclopropyl ring in not classified in class 548, subclass 452+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
12. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z together make a pyrrolidine or pyrroline ring which is fused with a cyclopropyl ring in not classified in class 548, subclass 452+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monophosphate.
13. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro furan ring which is fused with a cyclopropyl ring, classified in class 549, subclass 462+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
14. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro furan ring which is fused with a cyclopropyl ring, not classified in class 549, subclass 462+ where any of the R groups contain a sugar/sugar residue.

15. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro furan ring which is fused with a cyclopropyl ring, not classified in class 549, subclass 462+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
16. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro furan ring which is fused with a cyclopropyl ring, not classified in class 549, subclass 462+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
17. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro furan ring which is fused with a cyclopropyl ring, not classified in class 549, subclass 462+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
18. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro furan ring which is fused with a cyclopropyl ring, not classified in class 549, subclass 462+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
19. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro thiophene ring which

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- is fused with a cyclopropyl ring, classified in class 549, subclass 49+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
20. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro thiophene ring which is fused with a cyclopropyl ring, not classified in class 549, subclass 49+ where any of the R groups contain a sugar/sugar residue.
21. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro thiophene ring which is fused with a cyclopropyl ring, classified in class 549, subclass 49+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
22. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro thiophene ring which is fused with a cyclopropyl ring, classified in class 549, subclass 49+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
23. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro thiophene ring which is fused with a cyclopropyl ring, classified in class 549, subclass 49+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.

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24. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z together make a tetrahydro or dihydro thiophene ring which is fused with a cyclopropyl ring, classified in class 549, subclass 49+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
25. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z together make an imidazolidine or imidazoline ring which is fused with a cyclopropyl ring, classified in class 548, subclass 302.7+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
26. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z together make an imidazolidine or imidazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 302.7+ where any of the R groups contain a sugar/sugar residue.
27. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z together make an imidazolidine or imidazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 302.7+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
28. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z together make an imidazolidine or imidazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 302.7+ where any of

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the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.

29. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z together make an imidazolidine or imidazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 302.7+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
30. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z together make an imidazolidine or imidazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 302.7+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
31. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z together make an pyrazolidine or pyrazoline ring which is fused with a cyclopropyl ring, classified in class 548, subclass 356.5+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
32. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z together make an pyrazolidine or pyrazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 356.5+ where any of the R groups contain a sugar/sugar residue.

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33. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z together make an pyrazolidine or pyrazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 356.5+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
34. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z together make an pyrazolidine or pyrazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 356.5+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
35. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z together make an pyrazolidine or pyrazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 356.5+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
36. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z together make an pyrazolidine or pyrazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 356.5+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
37. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z together make a thiazolidine or thiazoline ring which is fused

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with a cyclopropyl ring, classified in class 548, subclass 152+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.

38. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z together make a thiazolidine or thiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 152+ where any of the R groups contain a sugar/sugar residue.
39. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z together make a thiazolidine or thiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 152+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
40. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z together make a thiazolidine or thiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 152+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
41. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z together make a thiazolidine or thiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 152+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.

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42. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z together make a thiazolidine or thiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 152+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
43. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z together make an isothiazolidine or isothiazoline ring which is fused with a cyclopropyl ring, classified in class 548, subclass 207+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
44. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z together make an isothiazolidine or isothiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 207+ where any of the R groups contain a sugar/sugar residue.
45. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z together make an isothiazolidine or isothiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 207+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
46. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z together make an isothiazolidine or isothiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 207+ where any of

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the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.

47. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z together make an isothiazolidine or isothiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 207+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
48. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z together make an isothiazolidine or isothiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 207+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
49. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z together make an oxazolidine or oxazoline ring which is fused with a cyclopropyl ring, classified in class 548, subclass 217+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
50. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z together make an oxazolidine or oxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 217+ where any of the R groups contain a sugar/sugar residue.

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51. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z together make an oxazolidine or oxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 217+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
52. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z together make an oxazolidine or oxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 217+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
53. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z together make an oxazolidine or oxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 217+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
54. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z together make an oxazolidine or oxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 217+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
55. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of the formula wherein X, Y and Z together make an isoxazolidine or isoxazoline ring which is

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fused with a cyclopropyl ring, classified in class 548, subclass 241+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.

56. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of the formula wherein X, Y and Z together make an isoxazolidine or isoxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 241+ where any of the R groups contain a sugar/sugar residue.
57. Claims 1-5, 21-22, and 29, drawn to a chemical compound of the formula wherein X, Y and Z together make an isoxazolidine or isoxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 241+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
58. Claims 1-5, 21-23, and 30, drawn to a chemical compound of the formula wherein X, Y and Z together make an isoxazolidine or isoxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 241+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
59. Claims 1-5, 21-23, and 31, drawn to a chemical compound of the formula wherein X, Y and Z together make an isoxazolidine or isoxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 241+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.

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60. Claims 1-5, 21-22, and 32, drawn to a chemical compound of the formula wherein X, Y and Z together make an isoxazolidine or isoxazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 241+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
61. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-triazolidine or 1,2,3-triazoline ring which is fused with a cyclopropyl ring, classified in class 548, subclass 257+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
62. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-triazolidine or 1,2,3-triazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 257+ where any of the R groups contain a sugar/sugar residue.
63. Claims 1-5, 21-22, and 29, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-triazolidine or 1,2,3-triazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 257+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
64. Claims 1-5, 21-23, and 30, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-triazolidine or 1,2,3-triazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 257+ where any of

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the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.

65. Claims 1-5, 21-23, and 31, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-triazolidine or 1,2,3-triazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 257+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
66. Claims 1-5, 21-22, and 32, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-triazolidine or 1,2,3-triazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 257+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
67. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-oxadiazolidine or 1,2,3-oxadiazoline ring which is fused with a cyclopropyl ring, classified in class 548, subclass 126+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
68. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-oxadiazolidine or 1,2,3-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a sugar/sugar residue.

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69. Claims 1-5, 21-22, and 29, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-oxadiazolidine or 1,2,3-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
70. Claims 1-5, 21-23, and 30, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-oxadiazolidine or 1,2,3-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
71. Claims 1-5, 21-23, and 31, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-oxadiazolidine or 1,2,3-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
72. Claims 1-5, 21-22, and 32, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-oxadiazolidine or 1,2,3-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
73. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-oxadiazolidine or 1,2,5-oxadiazoline ring which

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is fused with a cyclopropyl ring, classified in class 548, subclass 126+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.

74. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-oxadiazolidine or 1,2,5-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a sugar/sugar residue.
75. Claims 1-5, 21-22, and 29, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-oxadiazolidine or 1,2,5-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
76. Claims 1-5, 21-23, and 30, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-oxadiazolidine or 1,2,5-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
77. Claims 1-5, 21-23, and 31, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-oxadiazolidine or 1,2,5-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.

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78. Claims 1-5, 21-22, and 32, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-oxadiazolidine or 1,2,5-oxadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
79. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-thiadiazolidine or 1,2,3-thiadiazoline ring which is fused with a cyclopropyl ring, classified in class 548, subclass 126+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
80. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-thiadiazolidine or 1,2,3-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a sugar/sugar residue.
81. Claims 1-5, 21-22, and 29, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-thiadiazolidine or 1,2,3-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
82. Claims 1-5, 21-23, and 30, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-thiadiazolidine or 1,2,3-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where

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any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.

83. Claims 1-5, 21-23, and 31, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-thiadiazolidine or 1,2,3-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
84. Claims 1-5, 21-22, and 32, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,3-thiadiazolidine or 1,2,3-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
85. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-thiadiazolidine or 1,2,5-thiadiazoline ring which is fused with a cyclopropyl ring, classified in class 548, subclass 126+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
86. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-thiadiazolidine or 1,2,5-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a sugar/sugar residue.

87. Claims 1-5, 21-22, and 29, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-thiadiazolidine or 1,2,5-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
88. Claims 1-5, 21-23, and 30, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-thiadiazolidine or 1,2,5-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
89. Claims 1-5, 21-23, and 31, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-thiadiazolidine or 1,2,5-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
90. Claims 1-5, 21-22, and 32, drawn to a chemical compound of formula wherein X, Y and Z together make a 1,2,5-thiadiazolidine or 1,2,5-thiadiazoline ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 126+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
91. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of formula wherein X, Y and Z together make a oxathiazolidine ring which is fused with a

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cyclopropyl ring, classified in class 548, subclass 122 except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.

92. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of formula wherein X, Y and Z together make a oxathiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 122 where any of the R groups contain a sugar/sugar residue.
93. Claims 1-5, 21-22, and 29, drawn to a chemical compound of formula wherein X, Y and Z together make a oxathiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 122 where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
94. Claims 1-5, 21-23, and 30, drawn to a chemical compound of formula wherein X, Y and Z together make a oxathiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 122 where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
95. Claims 1-5, 21-23, and 31, drawn to a chemical compound of formula wherein X, Y and Z together make a oxathiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 122 where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.

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96. Claims 1-5, 21-22, and 32, drawn to a chemical compound of formula wherein X, Y and Z together make a oxathiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 122 where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
97. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of formula wherein X, Y and Z together make a dithiazolidine ring which is fused with a cyclopropyl ring, classified in class 548, subclass 123 except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
98. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of formula wherein X, Y and Z together make a dithiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 123 where any of the R groups contain a sugar/sugar residue.
99. Claims 1-5, 21-22, and 29, drawn to a chemical compound of formula wherein X, Y and Z together make a dithiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 123 where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
100. Claims 1-5, 21-23, and 30, drawn to a chemical compound of formula wherein X, Y and Z together make a dithiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 123 where any of the R groups contain a

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nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.

101. Claims 1-5, 21-23, and 31, drawn to a chemical compound of formula wherein X, Y and Z together make a dithiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 123 where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
102. Claims 1-5, 21-22, and 32, drawn to a chemical compound of formula wherein X, Y and Z together make a dithiazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 123 where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
103. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of formula wherein X, Y and Z together make a dioxazolidine ring which is fused with a cyclopropyl ring, classified in class 548, subclass 124 except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
104. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of formula wherein X, Y and Z together make a dioxazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 124 where any of the R groups contain a sugar/sugar residue.

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105. Claims 1-5, 21-22, and 29, drawn to a chemical compound of formula wherein X, Y and Z together make a dioxazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 124 where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
106. Claims 1-5, 21-23, and 30, drawn to a chemical compound of formula wherein X, Y and Z together make a dioxazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 124 where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
107. Claims 1-5, 21-23, and 31, drawn to a chemical compound of formula wherein X, Y and Z together make a dioxazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 124 where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.
108. Claims 1-5, 21-22, and 32, drawn to a chemical compound of formula wherein X, Y and Z together make a dioxazolidine ring which is fused with a cyclopropyl ring, not classified in class 548, subclass 124 where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.
109. Claims 1-5, 21-22, and 24-26, drawn to a chemical compound of formula wherein two of X, Y and Z are oxygen and/or sulfur and the other is carbon; or X, Y and Z

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are either oxygen or sulfur, classified in class 549, subclass 32+ except where the R groups contain a sugar/sugar residue, nucleoside, nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.

110. Claims 1-5, 21-22, and 27-28, drawn to a chemical compound of formula wherein two of X, Y and Z are oxygen and/or sulfur and the other is carbon; or X, Y and Z are either oxygen or sulfur, not classified in class 549, subclass 32+ where any of the R groups contain a sugar/sugar residue.
111. Claims 1-5, 21-22, and 29, drawn to a chemical compound of formula wherein two of X, Y and Z are oxygen and/or sulfur and the other is carbon; or X, Y and Z are either oxygen or sulfur, not classified in class 549, subclass 32+ where any of the R groups contain a nucleoside but not a nucleoside monophosphate, nucleoside diphosphate or nucleoside triphosphate.
112. Claims 1-5, 21-23, and 30, drawn to a chemical compound of formula wherein two of X, Y and Z are oxygen and/or sulfur and the other is carbon; or X, Y and Z are either oxygen or sulfur, not classified in class 549, subclass 32+ where any of the R groups contain a nucleoside monophosphate but not a nucleoside diphosphate or nucleoside triphosphate.
113. Claims 1-5, 21-23, and 31, drawn to a chemical compound of formula wherein two of X, Y and Z are oxygen and/or sulfur and the other is carbon; or X, Y and Z are either oxygen or sulfur, not classified in class 549, subclass 32+ where any of the R groups contain a nucleoside diphosphate but not a nucleoside monophosphate or nucleoside triphosphate.

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114. Claims 1-5, 21-22, and 32, drawn to a chemical compound of formula wherein two of X, Y and Z are oxygen and/or sulfur and the other is carbon; or X, Y and Z are either oxygen or sulfur, not classified in class 549, subclass 32+ where any of the R groups contain a nucleoside triphosphate but not a nucleoside diphosphate or nucleoside monotriphosphate.

115-229. Claims 33-53, drawn to the compositions comprising a carrier and a chemical compound, i.e. the pharmaceutical, corresponding to Groups 1-114, variously classified in 514.

230-344. Claim 71, drawn to a method of inhibiting glycosyltransferases, classified, variously classified, corresponding to the compound Groups 1-114.

If Applicant elects any of the compound Groups 1-114, the corresponding composition Groups 115-229 will be examined with the elected compound Group.

In accordance with the decisions in *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984), restriction of a Markush group is proper where the compounds within the group either (1) do not share a common utility, or (2) do not share a substantial structural feature disclosed as being essential to that utility. In addition, a Markush group may encompass a plurality of independent and distinct inventions where two or more members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the other member(s) obvious under 35 U.S.C. 103.

Where an election of any one of Groups 1-344 is made, an election of a single compound (or set of compounds) is further required including an exact definition of each substitution on the

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base molecule (Formula set forth in claim 1), wherein a single member at each substituent group or moiety is selected. For example, if a base molecule has a substituent group R1, wherein R1 is recited to be any one of H, OH, COOH, aryl, alkoxy, halogen, nucleoside, sugar/sugar residue, etc., then applicant must select a single substituent of R1, for example OH or specific aryl, specific sugar/sugar residue, specific nucleoside, etc. and each subsequent variable position, including salts and carriers. In the instant case, upon election of a single compound (or set of compounds), the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention will encompass all compounds within the scope of the claim, which fall into the same class and subclass as the elected compound (or set of compounds), but may also include additional compounds, which fall in related subclasses. Examination will then proceed on the elected compound AND the entire scope of the invention encompassing the elected compound. A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits. Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of compounds along with process of using said compound under examination. This will be set forth by reference to specific class(es) and subclass(es) examined. Should applicant traverse on the ground that the compounds are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the compounds to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the

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inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C 103(a) of the other.

All compounds falling outside the class(es) and subclass(es) of the selected compound and any other subclass encompassed by the election above will be directed to nonelected subject matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R. 1.142(b). Applicant may reserve the right to file divisional applications on the remaining subject matter. The provisions of 35 U.S.C. 121 apply with regard to double patenting covering divisional applications.

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventors must be amended in compliance with 37C.F.R. 1.48(b) if one of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37CFR 1.17(i).

Markush claims must be provided with support in the disclosure for each member of the Markush group. See MPEP 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the base molecule to be consistent with the written description.

Rationale Establishing Patentable Distinctiveness Within Each Group

Each Group listed above is directed to or involves the use or making of compounds which are recognized in the art as being distinct from one another because of their diverse chemical structure, their different chemical properties, modes of action, different effects and reactive conditions (MPEP 806.04, MPEP 808.01). Additionally, the level of skill in the art is

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not such that one invention would be obvious over either of the other inventions, i.e. they are patentable over each other. Chemical structures which are similar are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly. The presumption even for similar chemical structures though is not irrebuttable, but may be overcome by scientific reasoning or evidence showing that the structure of the prior art would not have been expected to function as the structure of the claimed invention. Note that in accordance with the holdings of Application of Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and In re Lahu, 223 USPQ 1257 (Fed. Cir. 1984), chemical structures are patentably distinct where the structures are either not structurally similar, or the prior art fails to suggest a function of a claimed compound would have been expected from a similar structure.

The above Groups represent general areas wherein the inventions are independent and distinct, each from the other because of the following reasons:

The inventions are distinct, each from the other because of the following reasons: the compounds of Groups 1-114 and 115-229 differ materially in structure and element so much so as to be patentably distinct. In addition, a reference which anticipates one group may not even render obvious the other.

Groups 1-114 and 115-229 and 230-344 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product (MPEP 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product as demonstrated throughout the specification,

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which are directed to several different methods of using the product, for example modulation of HIV infection and treating inflammation as well as starting materials or intermediates for the preparation of other useful compounds and compositions (See, e.g. pg. 6, [0020], pg. 8, [0030]).

In addition, because of the plethora of classes and subclasses in each of the Groups, a serious burden is imposed on the examiner to perform a complete search of the defined areas. Therefore, because of the reasons given above, the restriction set for is proper and not to restrict would impose a serious burden in the examination of this application.

Advisory of Rejoinder

The following is a recitation of M.P.E.P. §821.04, Rejoinder:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02© and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR 1.129(b), applicant may either (1) elect the invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and examined under 37 CFR 1.129(b)(2), or (2) elect the invention to be searched and examined and not pay the additional fee (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined. If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129(b)(2), even if the product is found allowable, applicant would not be entitled to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26 states that "[m]oney paid by actual mistake or in excess will be refunded, but a mere change of purpose after the payment of money...will not entitle a party to demand such a return..." The fees paid under 37 CFR 1.129(b) were not paid by actual mistake nor paid in excess, therefore, applicant would not be entitled to a refund.

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In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104 - 1.106. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

The following is a recitation from paragraph five, "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. §103(b)" (1184 TMOG 86(March 26, 1996)):

"However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim **depends from or otherwise includes all the limitations of** an allowed product claim. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined." (emphasis added)

Therefore, in accordance with M.P.E.P. §821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is (571) 272-2763.

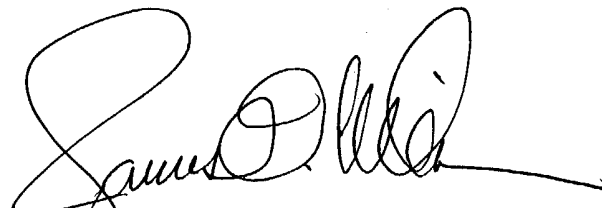
The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Ione Harle
September 29, 2004



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600